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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/658,239 | 09/08/2000 | Loren G. Knutson | 068520.0103 | 3004 |

7590 04/17/2003
Baker Botts LLP
2001 Ross Avenue
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EXAMINER

SHRADER, LAWRENCE J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2124

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DATE MAILED: 04/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | | |
|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 09/658,239 | | KNUTSON ET AL. | |
| | Examiner | | Art Unit | |
| | Lawrence Shrader | | 2124 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2,4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Specification***

The information disclosure statement filed on November 13, 2000 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the references were not cited on USPTO Form 1449. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Furthermore, cross-references related to other applications should be cited under the introduction section of the specification as per 37 CFR 1.154 (b) (2) and MPEP 1503.01.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1 – 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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As per claims 1 and 11, the term "different" in claims 1 and 11, all at line 3, is a relative term, which renders the claims indefinite. The term "different" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The examiner interprets "different" to mean distinct or separate from other function definitions.

Thus claims 2 – 10 and 12 – 20 are also rejected, as they are dependent on rejected base claims.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 and 11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of copending Application No. 09/657661 in view of Dougherty et al., U.S. Patent 6,370,575 (hereinafter referred to as Dougherty). The conflicting claims represent the same

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invention and differ by features that would have been obvious to one of ordinary skill in the art. Specifically:

In reference to claim 1, this claim recites a project definition including: a plurality of function portions each defining an input port and an output port, a source portion identifying a data source and data destination, and binding information associating an input port with an output port, all taught in claim 1 of the '661 application, which does not call for "a communications link." However, Dougherty teaches a web-based communication system allowing deployment and execution of a project definition file over a communications link (Abstract; column 10, lines 13 – 19). Therefore, it would have been obvious to one skilled in the art to combine the recitation of the '611 application with the teaching of Dougherty thus enhancing the '611 application so the definition files might be loaded and executed remotely through a communications link. Although, the combination of application '611 and Dougherty is provided with a separate application program wherein a function identifies a command (application '611), the combination will function the same without separate application program as referenced to claim 1.

In reference to claim 11, this claim recites a computer-readable medium corresponding to the features of claim 1, which has been rejected as set forth above. Thus, it also would have been taught in claim 4 of the '661 application in view of Daugherty as set forth above.

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This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 - 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mukherjee, U.S. Patent 6,226,322 in view of Koppolu et al., U.S. Patent 6,446,135 (hereinafter referred to as Koppolu), further in view of Dougherty et al., U.S. Patent 6,370,575 (hereinafter referred to as Dougherty).

In reference to claim 1, Mukherjee discloses a method of providing a set of distinct predetermined function definitions comprising:

"A plurality..." Mukherjee teaches a method comprising a configuration arranged as a plurality of functions with inputs related to outputs (column 6, lines 11 – 25; Figure 1).

"A further portion..." Mukherjee teaches a portion of the method that identifies a data source and an associated output port as well as a destination portion identifying the input port through which data is supplied (Figure 1, columns 5 – 6).

"Binding information..." Information is processed and an input is associated with a respective output (Figure 1, columns 5 – 6).

Mukherjee does not teach identification of a separate application program and a command identified with one of the functions. Koppolu discloses an application program

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having one of its functions identifying a command in a manner that affects data in the function (column 9, lines 30 – 40; column 14, lines 24 – 59).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine the method of defining a plurality of functions with related inputs and outputs as taught by Mukherjee with the identification of a function with an application and a command in the function as taught by Koppolu so that a set of different functions might be selected depending upon the input to the system and affect data by running the function in the application.

Mukherjee defines a plurality of function portions with source and destination ports binding the information to those ports. Neither Mukherjee nor Koppolu teaches the transmission of a project definition from one end of a communication link to another. Dougherty teaches a web-based communication system allowing deployment and execution of a project definition file (Abstract; column 10, lines 13 – 19). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine the method of defining a plurality of functions with related inputs and outputs as taught by Mukherjee with the identification of a function with an application and a command in the function as taught by Koppolu further modified to include communications link as taught by Dougherty for the purpose of updating the parameter file thus allowing flexibility to remotely change the parameter configuration as project requirements change.

In reference to claim 2, the rejection of claim 1 is incorporated. Mukherjee defines a plurality of function portions with source and destination ports binding the information to those ports. Neither Mukherjee nor Koppolu teaches the preparing step

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carried out at one end of a communications link followed by transmission of a project definition from one end of a communication link to another. Dougherty teaches a web-based communication system allowing deployment and execution of a project definition file (Abstract; column 10, lines 13 – 19, lines 45 - 51). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine the method of defining a plurality of functions with related inputs and outputs as taught by Mukherjee with the identification of a function with an application and a command in the function as taught by Koppolu further modified to include communications link as taught by Dougherty for the purpose of updating the parameter file thus allowing flexibility to remotely change the parameter configuration as project requirements change.

In reference to claims 3 and 4, the rejection of claim 1 is incorporated. Mukherjee teaches the method of configuring a communications link to include a network such as the Internet (column 5, lines 47 – 54).

In reference to claim 5, the rejection of claim 1 is incorporated. Mukherjee teaches the method of configuring a communications link to include a network such as the Internet (column 5, lines 47 – 54), which would include physically remote locations.

In reference to claims 6 – 10, the rejection of claim 1 is incorporated. Mukherjee defines a plurality of function portions with source and destination ports binding the information to those ports. Neither Mukherjee nor Koppolu teaches the storing and execution of project definition in response to communication through the communications link. Dougherty teaches an Internet web-based communication system allowing deployment and execution of a project definition file (Abstract; column 1 lines 42 – 44; column 10, lines 13 – 19, lines 45 - 51). Therefore, it would have been obvious

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to one skilled in the art at the time the invention was made to combine the method of defining a plurality of functions with related inputs and outputs as taught by Mukherjee with the identification of a function with an application and a command in the function as taught by Koppolu further modified to include communications link as taught by Dougherty for the purpose of updating the parameter file and executing the system based on the parameters thus allowing flexibility for a user to remotely initiate a change in the parameter configuration as project requirements change, and to allow various users to remotely initiate execution of the system based on the stored parameters.

In reference to claims 11 – 20 (computer-readable medium), they are rejected for the same reasons put forth in the rejection of claims 7 – 13 (method) respectively.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

U.S Patent 6,386,451 to Sehr, selection and execution of a plurality of operational functions.

U.S. Patent 6,374,353 to Settsu et al., selection and execution of a plurality of functional modules.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Shrader whose telephone number is (703) 305-8046. The examiner can normally be reached on M-F 08:00-16:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (703) 305-9662. The fax phone numbers for

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the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Lawrence Shrader
Examiner
Art Unit 2124



TUAN Q. DAM
PRIMARY EXAMINER

March 27, 2003